

REMARKS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS.

Claims 1-15 are pending in this application. Claims 1 and 9 are independent. In that, Applicants elect Group I Species A and Group II Species X (claim 6), claims 7 and 9-15 have been withdrawn from consideration. Claims 1-6 and 8 have been amended in this response. No new matter has been introduced.

It is submitted that the claims are patentably distinct over the prior art cited in the Office Action, and that these claims are now in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE 35 U.S.C. §103(a) REJECTION HAS BEEN OVERCOME

Claims 1-6 and 8 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,470,944 to Billings et al. (hereinafter, merely "Billings") in view of U.S. Patent No. 6,428,874 to McGahern et al. (hereinafter, merely "McGahern") and further in view of US 2002/0102894 to Hansen (hereinafter, merely "Hansen").

Claim 1 recites, *inter alia*:

"A single facer corrugator belt in combination with a corrugator machine, said belt comprising:

... a polymeric resin layer applied to at least one surface of said base structure; and a plurality of grooves formed in said polymeric resin layer."(emphasis added)

Billings is directed to an un laminated belt for a single-facer section of a corrugated board production line having a single base structure in the form of an endless loop. Applicants submit that Billings does not teach or suggest the above identified features of claim 1. Specifically, Applicants submit Billings does not teach or suggest a polymeric resin layer applied to at least one surface of the base structure; and a plurality of grooves formed in the polymeric resin layer. The fabric according to Billings is not grooved or holed in the sheet contact surface. The instant invention is therefore, an improvement thereon (See ¶ 0014, 0035-0037 and 0060-0061 of the specification).

McGahern relates to a resin-impregnated endless belt for a long nip press or calendar of the shoe type. It is directed to a shoe press belt with a grooved surface, which is to provide spaces to separate the liquid phase moisture that is pressed from a sheet/press fabric. The instant invention, on the contrary, relates to a single facer corrugator belt in combination with a corrugator machine that is specifically designed to allow moisture vapor that comes from the heated board to pass out of the facer zone and into the belt. This is an entirely different application having different requirements for proper operation and accordingly there would be no motivation for a skilled worker in the corrugator belt art to look into paper making belts to solve the problem addressed by the present invention.

In this regard, the Examiner states that Billings can be modified in view of McGahern, where grooves allow for temporary storage of water that is removed from the paper material as it is conveyed on the base structure and that it is well known in the paper processing art to make a belt from MD and CD yarns, wherein the base structure has passages/grooves for conveying

water away from the paper material being conveyed thereon and temporarily storing the water, as taught by Hansen.

Hansen relates to a fabric for the forming, press and dryer sections of a paper machine, for use as a reinforcing base for a paper-processing belt, or in other industrial settings where a material is being dewatered. Hansen refers to grooves being provided over one or both of the upper and lower surfaces of a monofilament yarn for temporary storage of water (§ 0021 and § 0052). Hansen does not teach grooves being formed over a polymeric resin layer over the surface of the fabric for storage of water. According to claim 1, the belt according to the present invention is clearly grooved or holed in the coating or polymeric resin layer, and not in the yarns of the base structure as cited in Hansen.

On page 4 of the Office Action, the Examiner asserts that it would have been obvious to one of ordinary skill in the art to have a plurality of grooves formed on the distinct resin layer that forms the outside surface of the base structure of Billings in view of McGahern and further in view of Hansen. Applicants respectfully disagree.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings either in the references themselves or in the general knowledge available to one of ordinary skill in the art; second, there must be a reasonable expectation of success; third, the prior art reference or references must teach or suggest all the claim limitations. M.P.E.P. § 2143. It is, however, impermissible for the Examiner to use hindsight based on an Applicant's disclosure to determine that an Applicant's invention is obvious in view of the cited art. M.P.E.P. § 2142. The motivation or teaching to make the claimed combination by modifying or combining prior art references must be found in the prior art and not in the Applicant's

disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). There is nothing that would motivate a skilled worker in the art to modify Billings with grooves from a shoe press fabric, a different application with its own needs and requirements. Also, in that Billings coating contains staple fiber, the desirability of cutting grooves thereon thus exposing the staple fibers is far from clear as something that would be desirable.

For at least the foregoing reasons, Applicants respectfully request the withdrawal of the rejection and submit that independent claim 1 is patentable.

III. DEPENDENT CLAIMS

The other claims are dependent from one of the independent claims, discussed above, and are therefore believed patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

CONCLUSION

In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference or references, it is respectfully requested that the Examiner specifically indicate those portions of the reference or references, providing the basis for a contrary view.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicant respectfully requests early passage to issue of the present application.

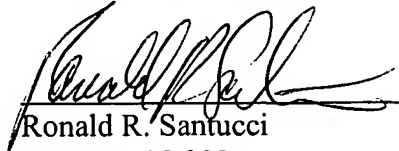
U.S. Patent Application No. 10/720,902
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Please charge any additional fees that may be needed, and credit any
overpayment, to our Deposit Account No. 50-0320.

Respectfully submitted,
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